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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/248,077      | 02/10/1999  | DAVID J. LADD        | 1298/0E486          | 8370             |

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03/13/2002

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NEW YORK, NY 10022

EXAMINER

SALAD, ABDULLAHI ELMI

ART UNIT

PAPER NUMBER

2153

DATE MAILED: 03/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/248,077

Applicant(s)

LADD, DAVID J.

Examiner

Salad E Abdullahi

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 October 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 12-16 and 27-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-16 and 27-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \*   c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

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**Response**

1. The response filed on 10/30/2001 has been entered and made of record.
2. Applicant's arguments with regard to claims 12-16 and 27-34 have been fully considered but are moot in view of the new ground(s) of rejection.

As per applicants' argument "Behr, nowhere discloses the use of a text-to-voice processor, the output of which is directed to a remote voice mailbox for storing the synthesized voice". In response to this argument, as per the voice mailbox is remotely located, this is not reflected in the claim language. Furthermore, Behr's system includes a text-to-voice processor (a speech synthesizer) as known in the art. Although, Behr's system is silent the text-to-voice processor transmitting the voice output to a remote voice mailbox, however, a text-to-voice converter which stores the voice output in a voice mailbox for later retrieval at the user's convenience is well known in the art.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claim 12 recites the limitation "said responsive information" in 7. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 12-15 and 27-29 and 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Behr et al U.S. Patent No. 5,543,789.

As per claims 12 and 27, Behr et al discloses a system for communicating with a wireless information device comprising the steps:

- receiving an information request (route guidance or route direction), (see fig. 1, the abstract and col. 5, line 66 to col. 6, line 13);  
as per receiving a device identification from a wireless device ( to receive a response to the information request a device identification would have been obviously included with the information request ). For example it would have been obvious the remote unit (pager 20) to provide the base unit a device identification which should receive response to the information request.
- accessing an informational database with the information request (see fig. 1, element 72);
- receiving from the informational database text format information in response to the request (see abstract);
- processing the text format with text-to-voice processor to generate an audio representation to the responsive information (see col. 4, lines 28-35).

While Behr sends an audio representation of the text response to the local storage means, Behr fails to disclose:

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sending the audio representation in a central voice mailbox.

Nonetheless, sending an audio representation to a central voice mailbox would have been an obvious modification to Behr's system. Although, Behr teaches the response may be stored in the memory such as 58 of the mobile units for later retrieval for. However, some of the mobile units such as pager 20 are known to include small memory with limited capacity. Furthermore, users of the mobile units might prefer not to be distracted with certain messages for certain times i.e, while driving in certain areas and would like their messages be send to a central location. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Behr et al to include a central voice mailbox in order to enable the users of the system to retrieve their audio messages at a later time at the their convenience.

- In considering 13-14, Behr et al discloses a system, wherein the information request contains plurality of geographic locations and the responsive information comprises driving direction between locations (see col. 3, line 51-67).
- In considering claim 15, Behr et al discloses a system, wherein the driving directions are provided in text or graphic format (see col. 3, line 51-67).
- in considering claims 28 and 29, Behr et al discloses a system, wherein the receiver comprises a computer server (see col. 3, line 46 and col. 4, lines 6-20).
- in considering claims 31 and 32, Behr discloses a system, wherein one of the connection to the informational database, the text-to-voice processor and the transmitter are contained on the same server (base unit) (see fig. 1, element 12).

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***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 16, 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Behr et al U. S. Patent No. 5,543,789, as applied to claims 12 and 27 above, and further in view of Imielinski et al U.S. Patent No. 6,240,448.

As per claims 16 and 30. Behr et al, discloses substantial features of the claimed invention including accessing the informational database from remote terminals through variety communications network.

Behr et al is silent the communications network through which the informational database is accessed includes Internet and is accessed through HTTP emulation.

Nonetheless, accessing an informational database or business directory or map database through the Internet is well known in the art as evidenced by Imielinski et al. Imielinski et al discloses a system, for accessing an informational database over a network, in particular the Internet obviously HTTP emulation (see col. 1, lines 9-30, and col. 2, lines 16-44). Therefore, it would have been obvious to one having ordinary skill in the art provided with the teaching of Imielinski et al to modify Behr et al, by employing an Internet as means of communication between remote

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unit and base unit (Messaging system) as taught by Imielinski et al, because Internet is especially advantageous, cost effective and user friendly communication means for retrieving data.

### **CONCLUSION**

9. The prior art made of record and relied upon is considered pertinent to the applicants disclosure.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Abdullahi E. Salad** whose telephone number is **(703) 308-8441**. The examiner can normally be reached on Monday to Friday from **8:30 AM to 5:00 PM**. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervise, Glen Burgess, can be reached at **(703)305-4792**. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is **(703)305-3900**.

**Any response to this action should mailed to:**

Box AF

Commissioner of Patents and Trademarks

Washington, DC 20231

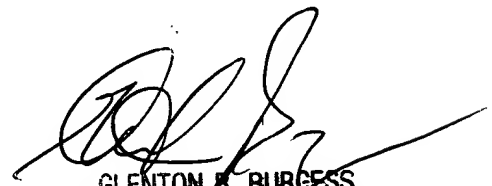
**or faxed to:**

**(703) 746-7238**, (after final communications)

**(703) 746-7239**, (Official communications)

**(703) 746-7240**, (Non-Official/Draft).

As  
2/25/002

  
**GLENTON B. BURGESS**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2100**